

DISCUSSION OF THE AMENDMENT

Claim 1 has been amended by excluding an isocyanurate of 1-isocyanato-3,5,5-trimethyl-5-isocyanatomethylcyclohexane (IPDI) from component (C). Support for the amendment can be found in both Examples 1 and 3, wherein component (C) is derived from the reaction of the isocyanurate and/or biuret of 1,6-diisocyanatohexane (HDI) as the only component (A) with the at least one emulsifier (C1). See also *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977) (**copy enclosed**) (holding that a claim to a genus with a recital of a negative proviso that did not appear in the specification complied with the description requirement.)

New Claim 23 has been added, to over the embodiment wherein no solvent is present.

No new matter is believed to have been added by the above amendment. Claims 1, 5-15, and 22-23 are now pending in the application.

REMARKS

Applicants thank the Examiner for the courtesy extended to Applicants' attorney during the interview held June 25, 2007, in the above-identified application. During the interview, Applicants' attorney explained the presently-claimed invention and why it is patentable over the applied prior art, and discussed other issues raised in the Office Action. The discussion is summarized and expanded upon below.

The rejections:

under 35 U.S.C. 102(b) of Claims 1, 5, 6 and 8-15 as anticipated by US 4,663,377 (Hombach et al); and

under 35 U.S.C. 103(a) of Claims 1 and 5-15 as unpatentable over Hombach et al in view of US 6,426,414 (Laas et al), and Claims 1, 5, 6, 8-15 and 22 as unpatentable over Hombach et al in view of US 6,472,493 (Huynh-Ba),

are respectfully traversed.

Hombach et al discloses an aliphatic polyisocyanate preparation in which an emulsifier sufficient to ensure the dispersibility of the polyisocyanate(s) is present (column 2, lines 13-19). The emulsifiers are produced by reacting the aliphatic polyisocyanates with hydrophilic compounds containing isocyanate-reactive groups (column 4, line 37ff). As previously argued, there is no disclosure or suggestion in Hombach et al to form an emulsifier based on HDI only, i.e., not based on HDI and IPDI, and to combine this emulsifier with IPDI, nor could Hombach et al have predicted the improved hardness obtained, as demonstrated by the comparative data of record, previously discussed.

The Examiner's response to the above argument is that the claims, prior to the above-discussed amendment, did not, in effect, exclude IPDI as a reactant in the formation of component (C). However, and as Applicants' attorney noted during the above-referenced interview, the above-discussed amendment now positively excludes this possibility.

Neither Laas et al nor Huynh-Ba remedy the above-discussed deficiencies of Hombach et al, since there is no disclosure or suggestion in either Laas et al or Huynh-Ba to form an emulsifier based on HDI and excluding IPDI, and to combine this emulsifier with IPDI.

During the above-referenced interview, the Examiner queried Applicants' attorney on the issue of negative limitations in claims vis-à-vis new matter. In that regard, see Harris A. Pitlick, *Looking Beyond Blazemarks on Trees -- It's Time to Revisit the Description Requirement in the Wake of Warner-Jenkinson*, 79 J. Pat. & Trademark Off. Soc'y 625 (1997) (This article is also available at www.oblon.com.) As can be verified therein, the above-discussed amendment raises no issue of new matter.

For all the above reasons, it is respectfully requested that the above rejections be withdrawn.

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Customer Number

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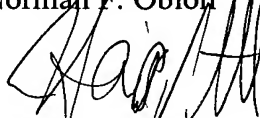
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